

Application No.: 10/603,952

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Docket No.: 297912001602

REMARKS

Applicants filed an Amendment on March 2, 2005 prior to the mailing of an office action to which this is a response; however, according to the office communication mailed June 6, 2005, the March 2, 2005 Amendment was not entered. Therefore, the listing of the claims herein, including additions and amendments, are intended to replace those filed in the March 2, 2005 submission. Claims 1-11 and 14-26 are pending in the application. Claims 11, 18 and 21 have been amended. Claims 23-26 have been added. Support for the amendment as well as the added claims can be found throughout the originally filed specification and drawings, for example, FIGS. 4-13 and col. 4:16-57. Applicants submit that no new matter or issues have been introduced.

Claims 1-5, 7-11 and 14-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ehrenfeld (USPN 5,156,619) in view of Possis *et al* (USPN 4,601,718). Claim 6 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ehrenfeld in view of Possis *et al*. Applicants respectfully traverse these rejections.

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (p. 2100-129, MPEP 2143, 8th Ed., Rev. 2, May 2004). Applicant asserts that a *prima facie* case of obviousness has not been established through the proposed combination of Ehrenfeld in view of Possis *et al* for at least the following reasons.

First, the proposed combination of Ehrenfeld in view of Possis *et al* is inappropriate because there is no motivation or suggestion to modify a tubular vascular graft attachable to an artery wall in the primary reference (Ehrenfeld) with a graft connectable to the aorta and the atrium of a heart in the secondary reference (Possis *et al*). Ehrenfeld fails to indicate that there is a problem with his arterial graft such that a modification is necessary or even desirable by taking elements from a heart graft of Possis *et al* and incorporating these elements into the vascular arterial graft of Ehrenfeld. Absent the benefit of applicant's own disclosure, there is no motivation or

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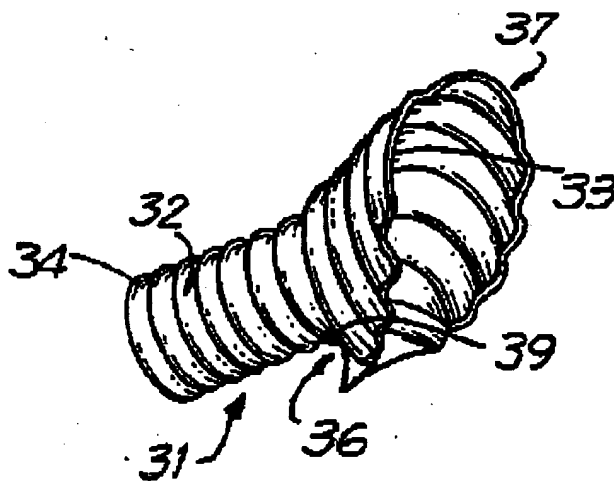
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suggestion to pick and choose elements from one reference (Possis *et al*) and combine them with another reference (Ehrenfeld). Thus, the claims are allowable for at least this reason.

Second, even if the restricted section 44 of Possis *et al* could be combined with the graft of Ehrenfeld, as the Examiner has proposed, the proposed combination could render the graft of Ehrenfeld unsuitable for its intended purpose. Hence, there is no motivation to combine. Specifically, Ehrenfeld describes at col. 3:22-29, that the graft 31 is woven or compacted then given a series of circular crimps.

**FIG. 4**

The flanged graft 31 is shown with a plurality of crimps 34 which present a series of undulating inner surfaces to blood flowing through the graft 31, which would cause flow that may not be smooth through the interior surfaces of Ehrenfeld, at least initially based on the configuration shown in FIG. 4. That is, the flow in Ehrenfeld may not be laminar due to the undulating inner surfaces of graft 31. The additional requirement that the Ehrenfeld device requires some sutures at the crotch region (col. 3:57-62) further complicates the surface profile in contact with blood flow.

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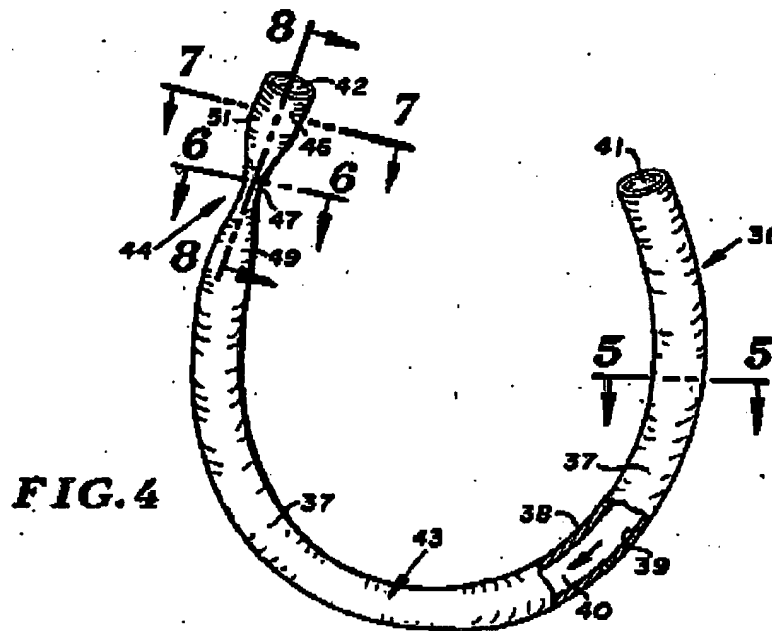
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In contrast, the graft 36 of Possis *et al* is shown in various embodiments as having smooth internal surfaces, which would result in laminar flow, as confirmed by Possis at column 8:39-45.

**FIG. 4**

Given that Ehrenfeld apparently utilized non-laminar flow in a graft for an artery and Possis *et al* utilized laminar flow for a direct heart bypass, one of ordinary skill in the art, at the time the invention was made, would not have implemented a restriction of Possis *et al* with laminar flow in a graft of Ehrenfeld that utilized non-laminar flow. Thus, such a modification could render the graft of Ehrenfeld unsuitable for its intended purpose. Where a proposed modification would render the modified device unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification (p. 2100-131, MPEP 2143.01, 8th Ed., Rev. 2, May 2004). Thus, the rejected claims are allowable for at least this reason.

New claims 23-26 are also patentable over the proposed combination for at least the reasons discussed herein.

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In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 297912001602. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 4, 2005

Respectfully submitted,

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